

REMARKS/ARGUMENTS

The present amendment is filed as the required response in connection with the request for continued examination filed on even date herewith. Accordingly, the present amendment should be entered in accordance with prescribed procedures. In addition, the amendment after final office action filed on June 30, 2003, is presumed to have been entered since the advisory action dated August 4, 2003, does not indicate non-entry of the amendment. However, applicant requests the examiner to enter the amendment dated June 30, 2003, in the event that this amendment has not been entered for any reason.

The examiner has raised various grounds for rejecting the claims in the final office action; and in the advisory action dated August 4, 2003, the examiner has provided additional comments with respect to applicant's previously submitted amendment and arguments. Before discussing the issues raised by the examiner in the final office action and the examiner's further comments in the advisory action, applicant first wishes to thank the examiner for the courtesy extended to the below signed attorney during the interview on October 3, 2003. The following comments constitute a separate substance of the interview as well as additional comments in support of the patentability of the claimed invention.

The examiner indicated during the interview that the phrase "the ratio of the combined thicknesses of the non-voided layers on the respective surfaces of the core layer being from 2:1 to 1:1" is difficult to understand. The below signed attorney emphasized during the interview that the above-quoted language in the claims (i.e., independent claims 13 and 28) is clear and unambiguous when read with the remaining portion of the claims. In this regard it is to be noted that the claims clearly refer to a film which includes an extruded core layer and at least one

substantially non-voided layer on each surface of the core layer. Thus, it is self-evident from the language of the claims that the "non-voided layer" on each surface of the core layer may comprise one or more non-voided layers in view of the claim language "at least one substantially non-voided layer co-extruded on each surface of the core layer". Furthermore, the one or more layers of non-voided material on either surface of the core layer will each have a combined thickness. In other words the one or more layers of non-voided material located on one side of the core layer will have a combined thickness and the one or more non-voided layers on the other side of the core surface will also have a combined thickness. It is also self-evident that the "ratio of the combined thicknesses" recited in the claims clearly refers to the ratio of the combined thickness of the non-voided material on one side of the core layer to the combined thickness of the non-voided material on the other side of the core layer. This ratio is clearly set forth in the claims as being "from 2:1 to 1:1". Thus, it is clear that this same concept can be expressed by the original claim language "the ratio of the combined thicknesses of the non-voided layers on the respective surfaces of the core layer being from 2:1 to 1:1".

As noted in the response filed on February 25, 2003, it is the relative thickness of the non-voided layers on either side of the core layer (i.e., the above-noted ratio) which provides the anti-curling benefit achieved in applicant's invention. This ratio must be from 2:1 to 1:1. Thus in the embodiment of the invention which includes only one non-voided layer on each side of the voided core layer, the ratio of thickness of one non-voided layer to the other non-voided layer must be from 2:1 to 1:1. Likewise, when the film includes two or more non-voided layers on each side of the voided core, the ratio of the combined thickness of the non-voided layers on the respective surfaces of the core layer is from 2:1 to 1:1. In this regard it is to be noted that examples 1-4 illustrate a film which contains 5

layers (i.e., a core layer containing an intermediate and an outer layer on one side thereof and an intermediate layer and an outer layer on the other side thereof). The embodiment of the invention which contains exactly five layers is specifically claimed in claim 30.

In each of the aforementioned examples, the ratio of the combined thickness of the non-voided layers on the respective surfaces of the core layer is within the range 2:1 to 1:1. For example, the combined thickness of the intermediate and outer layers on one side of the film of example 1 is 4.5 microns (3.0 microns for the intermediate layer and 1.5 microns for the outer layer). The other non-voided layers of example 1 on the other side of the core layer have a combined thickness of 4.0 microns (2.0 microns for the intermediate layer and 2.0 microns for the outer layer). Thus the ratio of the combined thickness of the non-voided layers on the respective surfaces of the core layer in example 1 is 4.5:4(1.125).

It is clear from the above discussion that the original language of claims 13 and 28 is clear and unambiguous with respect to the above-discussed ratios. However, in order to facilitate the examiner's better understanding of the invention, applicant has revised the language of claims 13 and 28 to more clearly state that which was clearly recited or at least implicit in the original language of these claims.

Each of the rejections raised by the examiner in the final office action were also discussed during the interview. In this regard it will be recalled that the examiner has rejected claims 13-36 under 35 U.S.C. § 103 as being unpatentable over WO '742. In addition the examiner has rejected claims 17-20 and 32 under 35 U.S.C. § 103(a) as being unpatentable over WO '742 in view of Crighton et al. and the examiner has rejected claims 21-24, 27 and 33 under 35 U.S.C. § 103(a)

as being unpatentable over WO '742 in view of Carespodì.

Each of the above rejections were traversed in the previously submitted amendment after final office action. However, the examiner notes in the last advisory action that contrary to applicant's arguments, the claims do not require that all of the layers which are co-extruded onto the core layer must be non-voided. (See paragraph 2 on page 2 of the advisory action). In other words the examiner was not persuaded by applicant's arguments that the invention is distinguished over the combined teaching of the cited references because there is no requirement that except for the core layer, all of the remaining layers must be non-voided.

In response to the points raised by the examiner in paragraph 2 on page 2 of the advisory action, applicant has further amended the claims to more particularly require that the only voided layer of the film is the voided core layer. Support for this limitation is found in the paragraph which bridges pages 4-5 of the specification wherein it states in part "Although only the core layer of films of the present invention should be voided, the other layers of films of the present invention can include additives provided they don't lead to substantial voiding".

With respect to the presently claimed absence of voided layers other than the voided core layer, applicant wishes to direct the examiner's attention to applicant's arguments found on pages 6-7 of the previously submitted amendment after final office action which establish that the primary reference relied upon in each of the rejections does not disclose or suggest an outer non-voided layer on a voided core layer as required in applicant's invention. Furthermore, it is to be noted that the primary reference provides absolutely no disclosure or suggestion that an anti-curling effect can be achieved by selecting the ratios of applicant's

invention. Moreover, selecting the ratios required by applicant in the films disclosed by WO '742 will not result in applicant's invention since WO '742 does not disclose a non-voided outer layer on a voided core layer as required by applicant's invention.

The Carespodi reference was also discussed during the interview in view of the examiner's remarks in the advisory action that this reference is particularly relevant to the claimed invention. Applicant submits that the presently claimed invention is distinguished over Carespodi for the reasons discussed below.

Before discussing the deficiencies of Carespodi, applicant first wishes to discuss the examiner's observation that the prior art references relied upon in the final office action are also associated with an anti-curling effect. The examiner's point that an anti-curling effect is achievable with other films is well taken. **However, it is not the anti-curling effect itself which applicant has discovered. Instead, applicant's discovery relates to the specific selection of the aforementioned ratios as a new and unobvious means for achieving an anti-curling effect.**

The mere fact that other films have an anti-curling effect does not mean that these films use the same ratios as recited in applicant's claims. This is because an anti-curling effect may be obtained by controlling other characteristics of the multi-layered film. Thus, contrary to the examiner's observation, there is no basis to conclude that other films which have an anti-curling effect inherently have the same ratio as recited in applicant's claims.

Turning now to the Carespodi reference, it is to be noted that Carespodi is not concerned with achieving an anti-curling effect for a co-extruded film. In this

regard applicant wishes to remind the examiner that Carespodi pertains to a **laminate** for making a container lid, not film for making a label. In addition, the layers used by Carespodi are laminated together by an adhesive. Thus, Carespodi addresses curling problems associated with the use of laminates in laminated films, not to curling problems associated with co-extruded films which do not depend on adhesive layers for bonding the outer non-voided layers to the voided core layer.

Applicant disagrees with the examiner's comments in paragraph 4 on pages 2-3 of the advisory action wherein the examiner asserts that there is only a single different feature which distinguishes the claimed invention from Carespodi. In fact, Carespodi relates to a **lid** whereas applicant's claims are directed to a **label**. The examiner ignores important differences between label technology and technology which pertains to unrelated lids applied to containers. A lid is sealed around the very small edge of a container and thus sealability with respect to the edge of the container material is a specific critical issue in lidding applications. The label is applied onto the surface of a container and provides information or decoration. The process of applying a label is different from the lidding process and one skilled in the art would not consult with lidding process technology to solve problems associated with unrelated labeling technology.

More importantly, Carespodi is concerned with lidding material **which is a laminate**, not the co-extruded film of applicant's invention. Moreover Carespodi does not teach or disclose to maintain the same thickness or to control the thickness relationship of the co-extruded layer or layers next to the voided layer. Carespodi requires that the laminate shall be symmetrical. However, symmetry according to Carespodi means that the structure and the heat resistance of components of the film (**i.e., the outer layers 14 and 18**) shall be the same (see

column 5, lines 29-35 of Carespodi). Carespodi additionally requires adhesive layers which are non-voided, but he is silent regarding the thickness of these layers. Thus it cannot be concluded that Carespodi teaches that **the combined** thickness of the non-voided layers on one side of the core and **the combined** thickness of the non-voided layers on the other side of the core are in the ratio required by applicant. In addition Carespodi does not teach that his structure is a laminate having *per se* low curl. Instead, Carespodi teaches that under the influence of heat the piece of laminate remains flat. That is logical if identical heat resistant materials are applied on both sides of the voided film. Thus if Carespodi is read carefully, it will be realized that even though Carespodi literally talks about curling, he does not refer to the same technical effect that applicants are concerned with. Carespodi prevents curling which occurs when a lidding laminate is exposed to heat. Heat prevents this effect by having the same material on both sides of the voided core layer. Specifically the same heat resistance on both sides. In this regard Carespodi notes that column 5, lines 33-35 that "Such symmetrical construction prevents the laminate 10 from curling when it is exposed to heat during the packaging operation".

Unlike Carespodi, applicants claim a label which has **co-extruded layers** and which remains flat when cut and stacked at room temperature. Curling at room temperature is not a problem with laminates because separate films are used in laminates and such separate films typically have sufficient stiffness to prevent any curl. In contrast, in a co-extruded film there are always two "different" outer layers, even though the material may be made of the same composition. This is because of the production process utilized in co-extruding films.

In the production process of a co-extruded film, **only one side will be in touch with the cooling drum shortly after extruding the melt whereas the**

other side will be chilled by air. Moreover, during the stretching process, both sides will experience different thermal conditions depending upon the temperature of the rolls which they contact while running through the process. In other words curling is far more critical with co-extruded films compared to laminates. Of course, one can avoid any curl very simply if you have one central layer and a laminate of identical films adhesively secured to each side. Applicant's invention is not concerned with the above-noted curling tendencies of laminates and as a teaching it does not direct one skilled in the art to solve different problems associated with co-extruded label film.

Also, in addition to the above-noted distinctions between Carespodì and applicant's invention, Carespodì is absolutely silent with respect to the density of the core layer. As one skilled in the art will appreciate, curling is more critical with lowered density and is more critical with higher degrees of voiding in the base layer. With increased voiding, the base layer is less stiff and cannot withstand curling, which is caused by the other layers. Carespodì is silent with respect to the density of the base layer.

In view of the above, it is clear that there is more than one difference between the disclosure of Carespodì and applicant's invention.

In view of the above arguments, it is clear that the examiner has not established a *prima facie* of obviousness. Furthermore, any allegation of *prima facie* obviousness is clearly rebutted by the comparative data contained in applicant's specification. However, the examiner argues in paragraph 3 on page 2 of the advisory action that the comparison discussed in applicant's last amendment is not pertinent because the comparison was not made against the closest prior art. Applicant most respectfully disagrees with the examiner on this

point.

The comparison discussed in applicant's last amendment is a comparison between the claimed invention and films which differ from the claimed invention only by the ratio lying outside of the critical ratio of applicant's invention. Thus, applicant has compared the claimed film with a film which differs from the claimed film only by a ratio which lies outside of the claimed range or ratios. The examiner has not cited any art which is closer to applicant's invention.

What can be closer to applicant's invention than a comparative film which has all of the features of the claimed invention except for the selection of the claimed ratio?

As noted in applicant's last amendment, applicant has made a comparison between the films of the invention (examples 1-4) and a comparison film (example 5). Examples 1-4 utilize the ratios recited in applicant's Independent claims (claims 13 and 28). Comparison example 5 uses a ratio which lies outside of this range (2.25:1). It is noted in the specification that the films of the invention (examples 1-4) showed no curl in the curl test which is described on page 5 of the specification. In contrast, the comparative film of example 5 showed a curl toward the printed face. Thus the comparative data contained in the specification is indeed a comparison between the closest prior art and this comparison shows unexpected benefits achieved with applicant's invention. In this regard applicant wishes to remind the examiner that comparative examples set forth in the specification which show unexpected results, **overcome any presumption of obviousness** (*ex parte Drewe et al.* 203 USPQ 1127).

Lastly, the double patenting rejection under 35 U.S.C. § 101 was discussed during the interview. In this regard the examiner urges in paragraph 5 on page 3 of the advisory action that the double patenting rejection is proper and that the proper test for a double patenting rejection under 35 U.S.C. § 101 is whether or not the two claims anticipate each other, not whether or not they may be of differing scope.

During the interview the below signed attorney referred the examiner to MPEP § 804 for the proper test in determining issues of double patenting under 35 U.S.C. § 101. In this regard MPEP § 804 states in part:

In determining whether a statutory basis for double patenting rejection exists, the question to be asked is: is the same invention being claimed twice? 35 U.S.C. § 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter.

MPEP § 804 describes a reliable test for double patenting under 35 U.S.C. § 101. In this regard MPEP § 804 also states in part:

A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope

of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and the statutory double patenting would not exist.

In view of the above, it is clear that contrary to the examiner's arguments, the proper test for double patenting under 35 U.S.C. § 101 is indeed whether the claims are of differing scope.

Claim 8 of the '490 patent is a label made out of the film of claim 1. Claim 1 recites "**optional** printing on an exposed surface of said film". In contrast, claim 28 of the present application is directed toward a label made from a polymeric film. Claim 28 recites "**said label including** printing on an exposed surface" of the film. Thus, it is clear that claim 8 of '490 is of broader scope than claim 28 of the present application since claim 8 optionally includes printing (and thus includes unprinted labels within the scope of the claim) whereas claim 28 specifically requires printing on an exposed surface of the film. Thus, pending claim 28 is not a duplicate of claim 8 of the '490 patent.

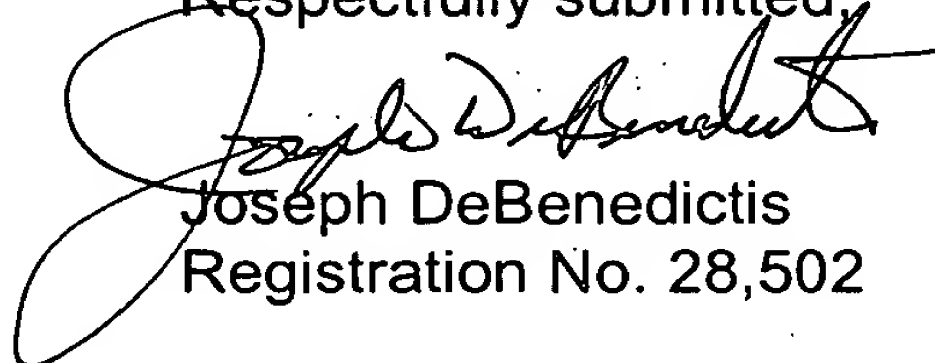
In view of the above arguments and further amendment to the claims, applicant respectfully requests reconsideration and allowance of all the claims which are currently pending in the application.

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